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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,930	01/26/2004	G. Randy Nicholson	1159-0003C2	9644

7590 06/24/2004

Steven W. Smith  
7237 Birchwood Drive  
Dallas, TX 75240-3609

EXAMINER
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JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/764,930

Applicant(s)

NICHOLSON, G. RANDY

Examiner

Jean D Janvier

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NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 35-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The title of the invention should be brief, descriptive and technically accurate. A preferred and suggested title is - -A Method for providing price-per-unit discounts for fuel to a customer- - . Furthermore, the abstract of the disclosure should not exceed 150 words (ca. 15 lines). See 37 CFR 1.72.

### ***Priority Information***

This Non- Provisional Application is a continuation of United States Non-Provisional Patent Application No. 09/991,815 filed November 17, now US Patent 6,732,081 B2, which is a continuation of Parent Application No. 09/253,275, now U.S. Patent No. 6,332,128 B1, which claims priority, under 119(e), from Provisional Application No. 60/093,813 filed July 23, 1998.

### **Status of the Claims**

Claims 35-45 are currently pending in the Instant Application.

### **Double Patenting**

The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Claims 35-45 are rejected under the judicially created doctrine of double patenting over claim1 of U. S. Patent No. 6, 732,081B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the Patent.

The subject matter claimed in the Instant Application is fully disclosed in the Patent and is covered by the Patent since the Patent and the Application are claiming common subject matter, as seen in the table below-

#### **Comparison Table 1**

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<p>Application No. 10/764,930</p> <p>Claim 35</p>	<p>US Patent 6,732,081</p> <p>Claim 1</p>
<p>35. A method of providing a discount on a price-per-unit (PPU) of fuel to a customer who purchases at least one cross-marketed product, said method comprising the steps of:</p> <p>awarding a first discount on the PPU of the <b>fuel</b> to the customer in response to a purchase by the customer of a first cross-marketed product <b>at a point-of-sale (POS) checkout;</b></p> <p>awarding a second discount on the PPU of the <b>fuel</b> to the customer in response to a purchase by the customer of a second cross-marketed product <b>at the POS checkout;</b></p> <p>adding by a processor, the first discount to the second discount to determine a total discount on the PPU of the <b>fuel;</b></p> <p>storing by the processor, the total discount in a discounts issued database;</p> <p><b>receiving by a fueling station controller, an indication that the customer has initiated a subsequent purchase of fuel, said indication including an identifier associated with the total discount stored in the discounts issued database;</b></p> <p>retrieving by the fueling station controller, the total discount from the discounts issued database; and</p> <p>reducing <b>by the fueling station controller</b>, the PPU of the <b>fuel</b> by the total discount.</p>	<p>1. A method of providing a discount on a price-per-unit (PPU) of a consumable good sold in multiple units to a customer who purchases at least one cross-marketed product, said method comprising the steps of:</p> <p>awarding a first discount on the PPU of the <u>consumable good</u> to the customer in response to a purchase by the customer of a first cross-marketed product;</p> <p>awarding a second discount on the PPU of the <u>consumable good</u> to the customer in response to a purchase by the customer of a second cross-marketed product;</p> <p>adding the first discount to the second discount to determine a total discount on the PPU of the <u>consumable good</u>;</p> <p>storing the total discount in a discounts issued database <u>which associates the total discount with a customer identification and a transaction identification;</u></p> <p><u>initiating by the customer, a subsequent purchase of the consumable good, said initiating step including inputting the customer identification and the transaction identification;</u> retrieving the total discount from the discounts issued database; and</p> <p>reducing the PPU of the <u>consumable good</u> by the</p> <p>total discount.</p>

Here, claim 35, for example, of the Instant Application Serial No. 10/764, 930 substantially recites the limitations of claim 1 of US Patent 6, 732, 081. Claim 35 merely omits the underlined limitations of claim 1 of the US Patent and replaces them with the **bolded limitations** as shown in comparison table 1 above.

Therefore, it would have been obvious to one of ordinary skill in the art of marketing at the time of the invention to modify the cited features as indicated in claim 35 of the Application since the omission and/or addition of the cited limitations would have not changed the system, as disclosed in the Patent, according to which a customer receives a total PPU discount on fuel for purchasing a first and a second cross-marketed items and after the customer has been identified, as would have understood one of ordinary skill in the art.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### **Conclusion**

Although the following references were not officially used in the Office Action, they are being considered as relevant prior art.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner

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by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

JDJ

06/21/04

*Janvier Jean Perio*